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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,993	12/07/2005	Frank Loeffler	04107/100M559-US1	7981

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EXAMINER	
WARE, DEBORAH K	

ART UNIT	PAPER NUMBER
1651	

MAIL DATE	DELIVERY MODE
10/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/559,993	LOEFFLER, FRANK	
	Examiner	Art Unit	
	DEBBIE K. WARE	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/3/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are presented for examination on the merits.

Response to Amendment

The Amendment filed **July 3, 2008**, has been received and entered. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The previous prior art rejection has been removed in light of the amendments as well as the previous rejection under 35 USC 112, second paragraph. However, new art has been applied in response to the newly presented claimed subject matter.

Information Disclosure Statement

The information disclosure statements (IDSs) submitted on December 7, 2005 and **July 3, 2008**, have been received. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 9-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the microorganism is required and recited in each of the claims, it is essential to the whole invention as recited in those claims. It must therefore be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the microorganism is not so obtainable or available, the requirements of 35 U.S.C. § 112 may be satisfied by a deposit of the microorganism. The specification does not disclose a repeatable process to obtain the microorganism and it is not apparent if the microorganism is readily available to the public.
It is noted that applicants have deposited the organism but there is no indication in the specification as to public availability.

If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. §§ 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a

statement by an attorney of record over his or her signature and registration number, showing that:

(a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and

(d) the deposit will be replaced if it should ever become inviable.

Applicant is directed to 37 CFR § 1.807(b) which states:

> (b) A viability statement for each deposit of a biological material defined in paragraph (a) of this section not made under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure must be filed in the application and must contain:
> (1) The name and address of the depository;
> (2) The name and address of the depositor;
> (3) The date of deposit;
> (4) The identity of the deposit and the accession number given by the depository;
> (5) The date of the viability test;
> (6) The procedures used to obtain a sample if the test is not done by the depository; and
>
> (7) A statement that the deposit is capable of reproduction.

Applicant is also directed to 37 CFR § 1.809(d) which states:

> (d) For each deposit made pursuant to these regulations, the specification shall contain:
> (1) The accession number for the deposit;
> (2) The date of the deposit;

(3) A description of the deposited biological material sufficient to specifically identify it and to permit examination; and
(4) The name and address of the depository.

Response to Arguments

Applicant's arguments filed July 3, 2008, have been fully considered but they are not persuasive. The argument that methods for obtaining the microorganism with the critical characteristics for carrying out the claimed methods are disclosed in the specification as filed is noted, however, there would be a high degree of unpredictability in the art required to select the specific strain BAV1 as claimed and as noted by Applicants' amendments to the claims wherein the specific strain is claimed there is an intention to deposit the particular strain. The requirement for deposit of the specific strain is sustained.

Claim Rejections - 35 USC § 102/103

a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 4, 5, 6, 7, 8, and 16-20 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sorenson (2002/0020665), or He et al, both cited on enclosed PTO-892 Form.

Claims are drawn to Dehalococcoides isolate for remediating a substrate comprising a halogenated compound which includes dichloroethene (DCE),and cis-DCE, vinyl-halide (halide can be chloride or bromide).

Sorenson teaches Dehalococcoides isolate for remediating a substrate comprising a halogenated compound which includes dichloroethene (DCE),and cis-DCE, vinyl-halide, including vinyl-chloride. Note page 2, [0010], all lines and page 3, [0025], all lines, and specifically lines 4-5, and line 6 from the bottom of page 3, [0025]. The abstract and page 3, [0024], line 2.

He et al teach Dehalococcoides isolate BAV1 for remediating a substrate comprising a halogenated compound which includes dichloroethene (DCE),and cis-DCE, vinyl-halide (halide can be chloride or bromide). See the entire abstract.

The claims are indentical to the cited disclosures and are, therefore, considered to be anticipated by the teachings therein. However, in the alternative that there is some unidentified claim characteristic for which there would be some difference between the claims and the cited prior art, above, then such difference is considered to be so slight as to render the claims obvious in the alternative thereof. It would have

been obvious to provide for a Dehalococcoides isolate for remediating a substrate comprising a halogenated compound which includes dichloroethene (DCE),and cis-DCE, vinyl-halide, including vinyl-chloride as shown and taught by the cited prior art. Each of the claimed features are disclosed by the cited prior art. The claims are rendered in the alternative prima facie obvious over the cited prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 2, 9, 10, 11, 12, 13, 14, and 15 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by He et al.

Claims are drawn to Dehalococcoides isolate BAV1 for remediating a substrate comprising a halogenated compound which includes dichloroethene (DCE),and cis-DCE, vinyl-halide (halide can be chloride or bromide).

He et al teach Dehalococcoides isolate BAV1 for remediating a substrate comprising a halogenated compound which includes dichloroethene (DCE),and cis-DCE, vinyl-halide (halide can be chloride or bromide). See the entire abstract.

The claims are identical to the cited disclosure of He et al and are, therefore, considered to be anticipated by the teachings therein.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE K. WARE whose telephone number is (571)272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DKW/
Deborah K. Ware
Examiner
Art Unit 1651

/David M. Naff/
Primary Examiner, Art Unit 1657